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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,463	02/26/2002	Wilma M Dausch	50683	3250

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Keil & Weinkauff
1350 Connecticut Ave., NW
Washington, DC 20036

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,463

Applicant(s)

DAUSCH ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 11-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11-16, 18-34 and 36 is/are rejected.
- 7) ☒ Claim(s) 17 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: English translation of JP 10-158140.

DETAILED ACTION

1. The Applicants' amendments filed on August 4, 2003, September 15, 2003 and October 15, 2003 was received. Claims 9, 11-12 and 14-23 are amended. Claim 10 is deleted. Claims 24-35 are added.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 24-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Beckham (US 6 191 215).

Beckham discloses a polymer obtained by free-radical polymerization of a monomer mixture of a) ethylenically unsaturated monomers such as those represented by formula IV, etc. , and b) polyalkylene oxide-containing silicone derivatives (Abstract, col. 1, line 46 to col. 2, line 31, col. 4, lines 1-54, col. 5, line 1 to col. 10, line 45 and Examples). The polymer can be used in pharmaceutical preparations (col. 12, lines 4-6). Component a) can be the monomers such as methacrylic acid, t-butyl acrylate, etc. (col. 7, lines 22-42).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9, 11-16, 18-23, 32-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blakenburg (WO 99/04750) in view of Sramek (US 4 871 529) and Habeck (JP 10-158140).

Blakenburg discloses a preparation obtained by free-radical polymerization of a monomer mixture of a) ethylenically unsaturated monomers and b) polyalkylene oxide-containing silicone derivatives of formula (I) (page 2, lines 16-25, page 10, line 24 to page 11, line 46 and Examples). The polymerization can be carried out in the presence of other polymers (page 9, lines 19-26). The preparation can be used for cosmetic hair formulation (page 12, lines 26-35). Note that the preparation can contain colorants (page 12, lines 36-42) so that it can be a decorative cosmetics.

The difference between Blakenburg and the present invention is the requirement of a) polypyrrolidones; copolymers of vinyl acetate and crotonic acid and/or vinyl neodecanoate or copolymers of vinyl acetate and/or vinyl propionate and N-vinylpyrrolidone; and b) a UV light protection filter.

With respect to a) Sramek discloses a cosmetic hair formulation comprising polysiloxane-polyoxyalkylene and polypyrrolidones; copolymers of vinyl acetate and crotonic

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acid and/or vinyl neodecanoate or copolymers of vinyl acetate and/or vinyl propionate and N-vinylpyrrolidone (Abstract and col. 5, line 52 to col. 6, line 50). Note that Sramek and Blakenburg are in the same field of endeavor. In light of which, it would have been obvious to one of ordinary skill in the art at the time of invention to find these copolymers and incorporate the them into Blakenburg's formulation, and thereby obtain the present invention.

With respect to b), Habeck teaches that it is well known in the art to use a screening agent in cosmetic formulations such as hair-care formulations, skin-care formulations, etc. ([0002]). Habeck further teaches the use of a UV light protection filter of formula I as a UV filter in cosmetic formulations. The motivation of using Habeck's UV light protection filter is to provide UV protection (Abstract, [0012]-[0022] and Examples). In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Habeck's UV light protection filter into Blakenburg's cosmetic formulation, and thereby obtain the present invention.

Response to Arguments

6. Applicant's arguments with respect to the previous rejection made by Blankenburg in view of Sramek, have been considered but they are not persuasive.

The Applicants' principal argument against the rejection is that "A key difference between the composition of Sramek and that of Blankenburg lies in the film-forming characteristics obtained thereby. In Sramek, the specific composition causes the hairspray resin to contract as it dries, imparting better holding properties. In contrast, the composition

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disclosed in Blankenburg forms a uniform film upon drying. The compositions are in the same field of endeavor, and yet they achieve different aims."

Applicants' argument is not persuasive because of the following reasons: It is noted that upon drying, Blankenburg's composition and Sramek's composition obviously will both contract because of the evaporation (loss) of the solvent. Furthermore, upon evaporating the solvent in the film, the film would contract uniformly because the thickness of the film in the field of Blankenburg and Sramek is typically thin, and the solvent would vaporize uniformly. Therefore, Examiner has a reasonable basis to believe that the films of Blankenburg and Sramek both have similar "uniformness".

7. Claims 17 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Blankenburg in view of Smarek and Habeck does not teach or fairly suggest a pharmaceutical preparation.

Beckham does not teach or fairly suggest a pharmaceutical preparation comprising a UV light protection filter and a polymer recited in the instant claim.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp
January 9, 2004


Kuo-Liang Peng
Primary Examiner
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